

**Results of Patent Survey  
for  
United States District Judge**

**T. John Ward**

**(September 23, 2003)**

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## **Results of Patent Survey for United States District Judge T. John Ward**

**1. What are the perceived advantages and disadvantages of the Court's local patent rules?**

- ◆ The cases move too fast to prepare the case.
- ◆
  - 1) Speed
  - 2) Logical progression of case
- ◆ The Court's local patent rules are similar to those used in the Northern District of California and provide for an orderly and efficient mechanism for adjudicating cases. In particular, requiring preliminary infringement and invalidity contentions early in the case (P.R. 3) focuses and defines the issues, thus narrowing discovery, and in particular, costly expert discovery. Also noteworthy is the claim construction procedure which is both efficient and logical (P.R. 4).
- ◆ The rules provide needed structure to an unwieldy process. They encourage full, fair disclosure promptly without motion practice.
- ◆ The advantages are that the claim construction issues are joined early. This benefits both plaintiffs and defendants because early claim construction provides quick assessment of the viability of the infringement claim.
- ◆ Speedy trial, full disclosure of documents, no hiding the ball until the last minute, and firm trial date.
- ◆ The advantage is that the rules customize the schedule for patent cases and take into account unique aspects such as *Markman* hearings and opinions of counsel. The disadvantage is that they create many additional deadlines that must be calendared, but that is probably inevitable in any patent case.
- ◆ Overall, very helpful.
- ◆ Advantages of the Court's local patent rules include a defined process that is substantially workable and a known timetable.

One disadvantage is that the early identification of accused products in the preliminary infringement contentions drives the disclosure obligations of the accused infringer. Because the discovery period begins shortly before the infringement contentions are due, it is not possible without discovery to identify all products that may infringe before the deadline for contentions.

- ◆ Advantage: The rules provide an orderly sequence of disclosures of the parties' respective positions on infringement, validity, and claim construction.
- ◆ Advantage - keeps discovery moving.
- ◆ It is good that the plaintiff must present its infringement case early, but defendants should not be bound by preliminary contentions. It adds much work for Defendants, which have a much greater burden already.
- ◆ For the most part, a lot of the guesswork as to what documents need to be disclosed is eliminated. This, of course, reduces the number of discovery disputes. Some confusion remains, however, when attempting to determine which disclosures / documents must be initially disclosed or pursuant to other deadlines.
- ◆ Avoids some disputes re: scheduling and scope of discovery. Timing tends to favor plaintiffs who have control over the start of clock by virtue of filing the complaint.

**2. Do you feel like the Court's mandatory disclosure discovery requirements, as compared to the disclosure and request for production procedure of the Federal Rules of Civil Procedure, is effective?**

- ◆ 4 respondents replied "yes."
- ◆ Mandatory disclosure requirements eliminate the need for drafting, objecting to, and responding to hundreds of document requests. Consequently, they reduce gamesmanship and provides for more efficient discovery.

The mandatory disclosure requirements need to be backed by meaningful penalties for noncompliance. Meaningful penalties could be the granting of an onsite inspection to gather documents, excluding the noncompliant party from using any documents not produced, and monetary sanctions.

- ◆ Yes, the mandatory disclosure requirements result in real production of documents rather than unnecessary objections and obfuscation that usually follow requests for production.

- ◆ Yes. The Court's rules mandate the disclosure of the critical documents for the parties to get to the heart of the infringement and validity issues.
- ◆ Yes. It is far more effective than the long delay caused by request for production practice with its attendant objections to every request and effort to avoid producing relevant documents.
- ◆ The mandatory disclosure requirements are generally effective. Especially effective are requirements that the patent owner disclose documents (and specifically identify the location where) that are related to first offer for sale and conception.

Because Rule 26 currently requires the parties just to disclose documents that support their claims or defenses, most parties routinely serve document requests in patent cases and do not rely on Rule 26 disclosures. The problem is that the parties sometimes try to crush their opponents by producing hundreds of thousands of documents, with the particularly important ones randomly sprinkled amidst documents of borderline relevance. It would greatly streamline and reduce expenses if the Court were to expand the requirement that the parties identify the bates numbers of documents pertaining to certain key issues in every patent case, like when the defendant had first hand knowledge of the patent, development documents for the accused device, attempts to design around, opinions of counsel, etc.

One issue regarding the preliminary contentions re: infringement and invalidity: It is unclear from the rules whether the parties may supplement their preliminary contentions without leave of court. Frequently, evidence adduced in discovery or additional prior art searches uncovers material that should be added to the preliminary contentions. The parties should be free to supplement / amend without leave of court until a certain cutoff date (perhaps shortly before the discovery cutoff) to allow that additional evidence to be included on the infringement and validity claim charts.

- ◆ There are some relevant documents that are not within the scope of the mandatory disclosure requirements. As a result, the practice has been to send letters requesting documents that are not addressed by the mandatory disclosure requirements. These letters are also used to identify documents that are considered within the scope of the mandatory disclosure requirements by opposing counsel. While this practice has had some success, many believe that using the request for production procedure would allow the parties to determine if "missing" documents are due to an objection to the requested documents or their non-existence.
- ◆ Yes, the disclosure requirements are effective.

- ◆ I think the formal procedure for requesting documents and getting a written response is necessary to know what has and has not been produced.
- ◆ Yes, more so. As stated above, the number of discovery disputes are reduced.
- ◆ Effective but too rushed for defendant at beginning of case.

**3. Do you think the Court's practice of including on privilege logs only those items about which claims of privilege may be disputed is effective?**

- ◆ 5 respondents replied "yes."
- ◆ Requiring a privilege log to be broken up into related bundles makes good sense. However, only providing a general description makes challenging the assertion of privilege almost impossible. For example, a bundle of documents described as "work product related to an investigation of possible infringement carried out in conjunction with in-house counsel" is likely privileged, it is not true that every single document in the bundle is necessarily privileged. In order to adequately assess the assertion of privilege, it is necessary that a "traditional" privilege log be provided.
- ◆ Yes, this allows the cost-saving option of not logging categories of documents neither party plans to challenge the assertion of privilege over.
- ◆ This possibly gives the attorneys too much discretion in deciding which items would be "disputed."
- ◆ Frequently, it is unclear whether an item may be disputed. For instance, when a defendant relies on a non-infringement opinion of counsel to refute a charge of willful infringement, it waives communications on that subject matter. The scope of the waiver is often unclear - does it just pertain to (a) the communications in the possession of the firm who issued the opinion, (b) other law firms who have communicated with the defendant about infringement issues, or (3) more broadly, even trial counsel's communications regarding infringement? A defendant may not put trial counsel's communications on the log, feeling they are not likely to be disputed, but the plaintiff may feel otherwise.

Unfortunately, privilege logs are time consuming to prepare and only a small portion of the documents on the log are ever even potentially disputed. However, it is difficult to draw an objective line that would eliminate the chaff and not prevent an unscrupulous litigant from also hiding the wheat.

- ◆ Under the current rule, only documents on which there are privilege disputes must be logged. It is difficult to ascertain all privilege disputes until after the discovery process has been going on for some time. Thus, this rule is not very effective.

It would be effective, however, to have the parties serve privilege logs under the current time line and then seek relief from the Court when and if there is a dispute. In fact, this currently is the practice.

- ◆ Definitely.
- ◆ I do not understand the Court's practice. Is this written down somewhere? It seems that any relevant documents withheld on grounds of privilege should be listed on a log.
- ◆ Yes. Sometimes, however, a list of documents or categories of documents must be exchanged when compiling the final privilege log for the opposing party to truly know which claims of privilege are disputed.
- ◆ Leaves too much to person creating log. Each party may view "disputed claims" differently.

**4. Do you feel that the disclosure of asserted claims and preliminary infringement contentions required of the patent claimant by the current patent rules provides adequate notice to the accused infringer?**

- ◆ 4 respondents replied "yes."
- ◆ The Court should require more substance.
- ◆ In the vast majority of cases, preliminary infringement contentions are sufficient to put a defendant on notice. Occasionally, identifying specific structure corresponding to each claim element is not practical. For example, in some semi-conductor- or computer-related patents, the patentee may not have a circuit diagram, source code, etc. However, the patentee may be able to ascertain to a high degree of certainty that the accused product infringes just based upon how the device operates.
- ◆ Yes. If not, that can be addressed on a case-by-case basis. Normally, however, the element-by-element claim charts provide adequate notice to the accused infringer.
- ◆ Yes, as interpreted by the Court. Any area of uncertainty can be clarified by interrogatory practice.



- ◆ Generally, these provide adequate notice. Again, my comments are subject to the observation in #2 above that the contentions should be permitted to be supplemented / amended without leave of court until some deadline (shortly before the discovery cutoff) to add/delete claims and provide additional factual support obtained through discovery.
- ◆ The preliminary infringement contentions provide the accused infringer notice of the asserted claims and the accused products. They may or may not provide the accused infringer notice of how the accused product purportedly infringes the asserted claim. Whether such notice is provided depends on the level of detail provided by the patent claimant. Some patent claimants merely substitute the name of the accused product into the claim limitation, while other patent claimants identify the specific feature or portion of the accused product and how it purportedly satisfies the claim limitation. The latter level of detail should be enforced by the Court.
- ◆ Yes. But this rule can be, and has been, exploited by the accused infringer to unreasonably limit discovery, particularly of products that are not public but which are about to become public and should be included in this case.
- ◆ The plaintiff must read the claim limitations on the accused device - anything less is not adequate.
- ◆ Generally speaking, yes. Certain technology can require more detailed contentions.
- ◆ Yes, but again timing somewhat difficult, particularly for patentee who has method / process claim and may not have details of actual accused process.

**5. Do you feel that the serving of preliminary invalidity contentions required by the current patent rules provides adequate notice for the patent claimant's purposes?**

- ◆ 7 respondents replied "yes."
- ◆ It is very difficult to prepare a defense in the time permitted.
- ◆ Yes. By and large, all the plaintiff needs is a full disclosure of the prior art reference. Requiring early disclosure of the prior art being relied upon is invaluable to reducing the amount of expert discovery needed in the case. This is particularly true in chemical and bio tech cases which will often involve a great deal of experimentation on prior art methods.

- ◆ Yes, the normal practice is for the accused infringer to provide claim charts on an element-by-element basis, as in the case of the preliminary infringement charts. This gives the patentee sufficient notice of the defendants' invalidity position, particularly given the subsequent detailed expert reports that are standard practice in such cases.
- ◆ Generally, these provide adequate notice. Again, my comments are subject to the observation in #2 above that the contentions should be permitted to be supplemented / amended without leave of court until some deadline (shortly before the discovery cutoff) to add / delete claims and provide additional factual support obtained through discovery.
- ◆ Yes, more than adequate. I do not believe that Defendants should have to have their invalidity case prepared so early in the process. Defendants should be free to amend based on discovery.
- ◆ Generally speaking, yes. Certain technology can require more detailed contentions.
- ◆ Same as above. Difficulty is that prior art more likely to develop over time rather than outset of case.

**6. How do you feel about the role of technical advisors in patent cases?**

- ◆ This would have been helpful.
- ◆ Very helpful.
- ◆ From a practitioner's perspective technical advisors are generally not necessary. Whether dealing with a jury or a judge, it is the duty of the lawyers to distill the technologies into an understandable presentation. However, from the Court's perspective, one can understand the attraction to using technical advisors in order to reduce the work load in the Court.

Concerns of an *ex parte* communication between the technical advisor and the Court are valid. Like all people, technical advisors can make mistakes. One purpose of the adversarial system is to provide the parties an opportunity to point out errors. This safeguard is by-passed when *ex parte* communications are allowed to occur.

Courts should also understand that most technical advisors will have some bias in their view. Some will be biased towards patentees, others biased against them. There is a raging debate among technical people regarding the societal effects of the U.S. patent system. It is difficult to imagine an advisor that is not biased in some direction.

Lastly, there is a Constitutional issue of having the parties pay for the technical advisor which I have not seen raised yet, and that is the Constitutional right to have access to the Court. While most patent cases are fought between corporate giants with a means to pay \$100,000 or more for a technical advisor, the issue remains.

- ◆ Technical advisors are necessary for many cases. They are preferable to special masters who simply assume the Court's role in claim construction.
- ◆ I have mixed feelings. If the Court believes that it needs additional help with the technology, the Court should be free to consult such an advisor. In most cases, however, I believe that counsel can properly educate the Court, possibly with the help of an expert, rendering a technical advisor an unnecessary added expense.
- ◆ I do not have any problem with it. Technical advisors are important to assist the Court with the technology. Clients often complain that the judge "doesn't understand the technology" and technical advisors help allay this concern.
- ◆ They are very valuable aids, given the often technically complex subject matter of patent cases.
- ◆ I am generally opposed to Special Masters in patent cases. Parties seek adjudication from an Article III judge because of impartiality. My experience with Special Masters is that the parties perceive (rightly or wrongly) that they wield quite a bit of power because the district judge probably does not have the time or technical inclination to perform a detailed or searching review of the paper record. The parties also perceive (rightly or wrongly) that Special Masters have become somewhat of a cottage industry, in that there are many patent lawyers who wish to make a name for themselves and garner more of that type of work. Whenever a person's future livelihood is involved, by definition he cannot be objective as an Article III judge.

Technical advisors are still subject to the same criticisms, but to a lesser extent, because the Article III judge is still firmly in the loop. There is a concern that the Technical Advisor can have *ex parte* discussions with the judge, but my view is that is just something the parties have to live with. It is unrealistic to expect district judges to understand the technology of semiconductors, computer software, DNA, telephony, etc. As long as the technical advisor educates the judge on technology, and not the law of patent claim construction, there should be no problem. However, that is impossible to verify given that the discussions are *ex parte*.

- ◆ There is no question that technical advisors / special masters are here to stay. Given a choice between the two, I lean strongly towards a technical advisor as opposed to a

special master. I also think the Federal Court prefers technical advisors because the district judge stays more involved in the proceedings.

- ◆ While I have not had occasion to experience the role of a technical advisor in a case before this Court, I have had some general experience with it elsewhere. I would suggest that the Court ensure that the technical advisor chosen is not a lawyer that practices frequently in the Court, in order to eliminate any perceived “enhanced credibility” the technical advisor / practicing lawyer may have in front of the Court in other cases.
- ◆ I believe them to be very helpful and even-handed.
- ◆ It is difficult to assess how much input the technical advisor has in the process. This would be less disconcerting if the Court used individuals who are truly experts in the relevant technical field, rather than patent lawyers.
- ◆ Appropriate in very complex cases.
- ◆ Helpful.
- ◆ O.K. as long as the advisor's reports are made part of the record and the parties may be allowed to comment on the reports.
- ◆ In those instances where the Court feels that it needs assistance in understanding and applying the technology, having a technical advisor can be helpful (and even necessary). However, selecting a technical advisor by agreement among counsel is usually difficult, time consuming and almost too much trouble.
- ◆ Should be used sparingly and/or only upon agreement of both parties.

**7. How would you feel about a special master being appointed in a patent case?**

- ◆ The special master should have patent experience.
- ◆ Again, I would have the same concerns about a special master as I would a technical advisor.
- ◆ May be helpful under certain circumstances, however, loss of continuity / disconnect must result.

- ◆ I feel that the technical advisor process is preferable because of the Court's continued involvement.
- ◆ In most cases, I feel that such advisors are unnecessary, particularly given the Federal Circuit's preference for intrinsic evidence over extrinsic evidence in the claim construction process.
- ◆ Special masters are a substitute for the judge. I am opposed to special masters doing the job of the judge.
- ◆ Special masters can serve a very valuable role - for example, in presiding over *Markman* hearings.
- ◆ I am generally opposed to Special Masters in patent cases. Parties seek adjudication from an Article III judge because of impartiality. My experience with Special Masters is that the parties perceive (rightly or wrongly) that they wield quite a bit of power because the district judge probably does not have the time or technical inclination to perform a detailed or searching review of the paper record. The parties also perceive (rightly or wrongly) that Special Masters have become somewhat of a cottage industry, in that there are many patent lawyers who wish to make a name for themselves and garner more of that type of work. Whenever a person's future livelihood is involved, by definition he cannot be objective as an Article III judge.

Technical advisors are still subject to the same criticisms, but to a lesser extent, because the Article III judge is still firmly in the loop. There is a concern that the Technical Advisor can have *ex parte* discussions with the judge, but my view is that is just something the parties have to live with. It is unrealistic to expect district judges to understand the technology of semiconductors, computer software, DNA, telephony, etc. As long as the technical advisor educates the judge on technology, and not the law of patent claim construction, there should be no problem. However, that is impossible to verify given that the discussions are *ex parte*.

There is no question that technical advisors / special masters are here to stay. Given a choice between the two, I lean strongly towards a technical advisor as opposed to a special master. I also think the Federal Court prefers technical advisors because the district judge stays more involved in the proceedings.

- ◆ Alright.
- ◆ Other judges in the district use special masters effectively. Their use should be considered by this court, especially when the technology at issue is complicated.

- ◆ Prefer a technical advisor. Special master seems to supplant the Court to a degree.
- ◆ Prefer direct dealing with the judge, although use of special assistant is fine.
- ◆ For discovery, usually an unnecessary and expensive option.
- ◆ In those instances where the Court feels that it needs assistance in understanding and applying the technology, having a technical advisor can be helpful (and even necessary). However, selecting a technical advisor by agreement among counsel is usually difficult, time consuming and almost too much trouble.
- ◆ Should be used sparingly and / or only upon agreement of both parties.

**8. Do you feel you are given enough time to present your arguments in the *Markman* hearings?**

- ◆ 6 respondents replied "yes."
- ◆ 1 respondent replied "no."
- ◆ Yes. In most cases, a full day is sufficient. Requiring the use of representative claims (see 17 below) would greatly reduce the number of claim terms requiring construction.
- ◆ Yes. Any more time simply multiplies the number of issues that are raised, thereby diluting the few critical claim construction issues in any case.
- ◆ Generally, one day should be enough for a *Markman* hearing in all but the most technical of cases. In cases involving multiple patents on inverse technologies, one day per patent should be enough.
- ◆ The amount of time necessary for a *Markman* hearing depends in part on the number of patents and range of technologies that may be covered by the patents. A one day (7 ½ hour) *Markman* hearing is sufficient time when the technologies are similar or the patents are related to one another.
- ◆ I haven't presented a *Markman* hearing in this court yet. Generally a complex case may involve a full day of argument.
- ◆ Yes, the Court always takes into account the nature and complexity of each case and considers the requests of counsel.

9. **Do you prefer expert reports to be completed before the *Markman* hearing and then supplemented, or do you prefer to have expert reports completed after the *Markman* ruling?**

- ◆ After *Markman* ruling or a new set of reports have to be prepared anyway in view of *Markman*. A new expert may be needed.
- ◆ Experts are almost never needed at the *Markman* stage. Experts are generally used to give the background of the technology. However, a well-schooled attorney is perfectly capable of laying out the same presentation.

Occasionally, experts are also used to interpret claim terms as one of ordinary skill in the art. This, of course, may invite error on appeal. Generally, when used in this capacity, the expert just reviews the relevant portions of the prosecution history and specification - all of which the attorneys could do without the necessity of an expert.

There is only one instance in which experts are needed at the *Markman* stage. On rare occasion, a patent claim may contain a term that is truly a term of art and not defined in the intrinsic record. In such cases, the terms may be found in technical dictionaries or technical papers. However, there are very rare occasions in which such terms are not so found or are vaguely defined. These rare cases are more likely to arise in rapidly evolving technologies like computers and bio tech where the definitions of certain terms evolve and become vague.

- ◆ Before, then supplemented.
- ◆ Expert reports are more useful after the *Markman* ruling.
- ◆ Expert reports on claim construction obviously need to be completed before the *Markman* hearing. Other reports (e.g. infringement and validity) should be due a certain time after the Court's claim construction ruling.
- ◆ Prepared first, then supplemented. The parties know what their construction is when reports are prepared. If *Markman* is done first, trial within 12-14 months will be delayed.
- ◆ Prefer for the reports to be completed prior to the hearing - more like trial practice, where reports are completed in advance of trial, to give each side notice of the opinions that will be offered.

- ◆ I strongly feel that expert reports on the infringement / validity should be in before *Markman* and then supplemented. Usually the *Markman* ruling only requires slight to moderate supplementation of the reports. It is only fair to know what the other side contends with regard to infringement / validity before going into *Markman* to protect against getting sandbagged by slightly ambiguous wording in a proposed construction that the advocating party will twist to its advantage later.

- ◆ Before.

- ◆ Expert reports should be completed after the *Markman* ruling. In fact, the entry of the *Markman* ruling should trigger deadlines for expert reports, expert discovery, fact discovery on willfulness and filing of dispositive motions. A proposed schedule for such deadline is set forth below.

15 days after <i>Markman</i> ruling	Party with burden designates experts and serves opening reports. Accused infringer must respond to willfulness claim under P.R. 3-8.
30 days after <i>Markman</i> ruling	Patent claimant's final infringement contentions due under P.R. 3-6(a).
35 days after <i>Markman</i> ruling	Parties serve rebuttal expert report. Patent claimant to designate willfulness expert and serve report.
45 days after <i>Markman</i> ruling	Accused infringer to designate willfulness expert and serve report.
50 days after <i>Markman</i> ruling	Accused infringer's final invalidity contentions due under P.R. 3-6(b).
60 days after <i>Markman</i> ruling	Expert discovery closes.
70 days after <i>Markman</i> ruling	Dispositive motions deadline .

- ◆ After the *Markman* hearing.
- ◆ Expert reports on infringement / validity should be done after *Markman* ruling.
- ◆ Expert reports should not be due until after the court decides on the claim construction. It just doesn't make sense to do them before then, and it is a waste of money.



- ♦ I believe that the preferred procedure is to have expert reports completed after the *Markman* rulings. This process is fairer to both parties when the experts on both sides of the case have the benefit of the Court's claim construction when preparing their reports.
- ♦ After.

**10. How do you feel about the pace at which the Court moves cases?**

- ♦ Too fast to prepare the case properly.
- ♦ Fast dockets generally favor the plaintiff. This is certainly true in most patent cases. Many defenses to a charge of infringement require a substantial amount of time and discovery to develop. For example, a thorough prior art search typically takes about 2-3 months. In addition, there is a great deal of prior art at universities in the form of dissertations around the world which can be searched by visiting the university. This is a very time-consuming procedure, although many major U.S. universities are beginning to make these papers available on-line.
- ♦ Good.
- ♦ The pace is excellent.
- ♦ Good. The Court's schedule moves the case along without putting defendants at a disadvantage.
- ♦ The pace is fair to all sides and saves clients the expense of 2-5 years patent litigation.
- ♦ The pace is reasonable.
- ♦ The Court's pace is among the best in the country, 12-14 months from answer to time of trial is ideal.
- ♦ Excellent.
- ♦ In most cases, the Court moves the cases at a pace that is fair to both the patent claimant and the accused infringer. However, the Court should also have a track for complex cases. In determining whether a case should be on a complex track, the Court should consider the number of patent disclosures at issue, the number of asserted claims, the number of accused products, and the complexity of the technology.

The trial date for a case on the complex track would be determined based on these factors.

- ◆ The Court is prompt.
- ◆ Good pace.
- ◆ Much too fast for defendants, especially when all the additional work of the Northern District of California Patent Rules is added. These rules and a "rocket docket" are not compatible, and put severe burdens and time pressures on defendants, especially when the defendant was not aware of the patent before the lawsuit.
- ◆ The pace at which the Court's docket moves is fine. I am not aware of any case in which the parties have been unable to comply with the scheduling order or, when necessary, secure the Court's approval of their requests to modify the scheduling order.

**11. How do you feel about interim arguments? How should interim arguments be structured?**

- ◆ Very good ideas
- ◆ Very helpful in cases with numerous claims or complicated technology.
- ◆ Allowing parties an opportunity to present argument at times of their choosing through a complex case, especially one of counterclaims, is helpful in focusing the jury's attention. Each side could get 30 minutes to use as they please.
- ◆ Interim arguments are something I have never seen. In a lengthy trial, they might be helpful.
- ◆ I like interim arguments as long as they do not become distracting. They help keep the jury focused and probably answer a lot of unasked questions along the way (such as "Why did you just do that?" and "What is going to happen next and why?")
- ◆ These are a two-edged sword. They are useful to keep the jury from getting confused, but they can become too argumentative and become subject to abuse.
- ◆ The standard for interim argument should be similar to an opening: a forecast of what they witness will say and what issue(s) it is relevant to. That's it - no arguing the case.
- ◆ Creative and useful in this kind of complex litigation.

- ♦ Interim arguments are useful to the jury and should be used in every case.

In terms of structure, the accused infringer should have the last word during the patent claimant's case-in-chief. During the accused infringer's case, the patent claimant should have the last word. Each interim argument should be no more than ten minutes with a total of 90 minutes for the trial.

- ♦ I would prefer no interim arguments, so as to reserve all arguments to closing.
- ♦ I like interim arguments. I believe it helps the jury follow the evidence. Depending on length of trial and number of witnesses and issues, perhaps once a day with equal time to both sides - one argument each with no reply
- ♦ I do not know what these are.
- ♦ I feel that interim arguments are potentially helpful to juries, particularly in patent litigation. Allowing the parties to choose when to use interim arguments (with notice to the other side as ordered by the Court) works fine.

## **12. How do you feel about venire questionnaires?**

- ♦ Counsel needs to have more input and ability to control the process.
- ♦ Very helpful.
- ♦ They are helpful and efficient.
- ♦ I like the questionnaires provided by the court.
- ♦ They can give some useful advance information about jurors, to help streamline the voir dire process,
- ♦ Strongly support, as long as the length is in reason.
- ♦ It is most helpful.
- ♦ They should be used in every case.
- ♦ They are a good idea, they allow for a meaningful jury selection process.

- ◆ Only somewhat helpful.
- ◆ Parties should be able to get some info from jurors.
- ◆ Jury questionnaires are very helpful and give the parties some direction when preparing for voir dire. This results in shorter and more focused voir dire.

**13. Are the facilities in Marshall adequate to try intellectual property cases? If not, what improvements either in equipment or facilities would you recommend? (Comments will be particularly useful to the Court given the present stage of the renovation project.)**

- ◆ 1 respondent replied "yes."
- ◆ The Court Room is too small for a large case.
- ◆ The court room facilities in Marshall are comparable to those found in much larger cities and certainly adequate to try an IP case.
- ◆ Yes, but more space and more power supply.
- ◆ Additional space in and around counsel tables would be helpful. Also, better use of space by building in demonstrative equipment would be a plus.
- ◆ The facilities are not adequate. There are no meeting rooms for lawyers, clients and witnesses. I am constantly concerned that a juror will overhear a conversation between lawyers or a client because there is no place to work.
- ◆ Built-in flat-panel monitors (at each counsel table, at the witness stand, for the judge, and for the law clerk, and several for the jurors) would be helpful to eliminate taping wires and cables down all over the place. (Judge Prado's court in San Antonio would be an excellent model for trying high-tech cases.)
- ◆ The standard federal LCD / Touchscreens and Elmos are fine. Typically, if the parties need anything more, they can bring it into the court themselves.
- ◆ The current facilities are fundamentally adequate, but some upgrading is needed in lighting, acoustics and correction of circuits breaking unnecessarily.
- ◆ Properly-sized flat panels should be placed in the jury box for access by the jurors in addition to the large projected image. It would also be helpful to have a wireless lapel microphone system.

- ◆ The facilities are good.
- ◆ Current facilities are adequate. Greater electronic capabilities would be nice, similar to those in Texarkana (Judge Folsom's courtroom).
- ◆ The Court looked fine to me. I liked the pre-installed Elmo and monitor set-up. In most courts, this must be provided by the parties.
- ◆ Yes, the existing technological and equipment improvements seem to be adequate. Attorneys from outside the district believe that our facilities are more than adequate. I would recommend that the present renovation project incorporate a "bench" or stand (separate from the Court's) for a special master or a technical advisor whose presence is required by the hearings or trials.

**14. Do you think a tutorial witness appointed by the Court for the purpose of explaining patent cases to the jury would be beneficial?**

- ◆ 1 respondent replied "yes."
- ◆ 1 respondent replied "no."
- ◆ Yes, as long as both sides agree on what is said.
- ◆ Lawyers should be allowed to present their own cases and are capable of explaining the technology and background to a jury. A tutorial witness will always have some bias and run the risk of making mistakes. Correcting a witness that the jury views as neutral or Court sanctioned is very difficult.
- ◆ Have not seen that done before but seems as if it should work well.
- ◆ No. The parties can adequately perform this education process and tailor it to the case at hand through opening statements.
- ◆ No, this should be left to the parties.
- ◆ Yes. Either that or a video.
- ◆ This could be a breeding ground for many objections by counsel if one side or the other didn't like the way it was explained. Currently, counsel usually agree on preliminary

instructions that explain generally how patent cases work. But counsel would not have a chance to review in advance what a tutorial witness might say.

- ◆ If the tutorial witness is to explain the patent system, that is a good idea. The Federal Judicial Center puts out a videotape that contains a balanced explanation of the patent system, which the Court might consider a better alternative. It runs about 20 minutes.

If the tutorial witness is to explain the field of technology, I think that one (or both) of the parties may feel aggrieved based on the way the expert discusses the technology. Because the tutorial witness is appointed by the Court, both sides may feel reluctant to cross him. Better would be to allow the plaintiff to call one of its technical experts just to give a tutorial, and limit cross to the subject matter of the tutorial.

- ◆ Yes, if a neutral witness with good teaching skills can be located and the boundaries of the tutorial are agreed to by the parties.
- ◆ I would rather each party have its own.
- ◆ No, just adds more work for the parties to battle over what the "witness" would say. The judge should provide a brief overview.
- ◆ I believe that the Court can adequately fill that role and should. Given that the Court has ample opportunity to explain the proceedings and to instruct the jury, and the attorneys are allowed to make opening, interim and closing arguments to the jury, I see no need for a tutorial witness.

**15. Do you think a video prepared by the Federal Judicial Center explaining patent cases to the jury as a preliminary instruction would be beneficial?**

- ◆ 1 respondent replied "yes."
- ◆ 2 respondents replied "no."
- ◆ No, the jury will just fall asleep.
- ◆ Again, I think this undercuts the adversarial process and impinges upon the realm of the lawyer. In addition, if such a video were sought, I would turn to an organization like AIPLA rather than the Federal Judicial Center.
- ◆ Yes, although may be confusing.

- ◆ Yes, This could provide useful preliminary education to jurors.
- ◆ Possibly.
- ◆ As long as counsel for each side had a chance to review and object.
- ◆ Very helpful.
- ◆ Questionable. Better if prepared under direction of the trial judge.
- ◆ The one currently in existence is probably worth trying. It is evenly balanced and well done.
- ◆ One suggestion would be to allow the parties to review the video before it is presented to the jury, so that they can raise any concerns about its content. The Court could then make a statement to the jury addressing the areas of concern. For instance, the video refers to the burden on invalidity as "highly probable." If the accused infringer has a concern with this language, the Court can explain to the jury that the standard is "clear and convincing."
- ◆ Not particularly - the number of issues potentially in a patent case is large, and I find it better to tailor preliminary instructions for the particular issues actually involved in a case.
- ◆ Perhaps, that would eliminate the possibility for disputes over a tutorial witness.
- ◆ Perhaps if it is very general and not too long. Such a video should not exceed 20-25 minutes.

**16. Are there any rules you think should be changed, and if so, how would you change them?**

- ◆ 3 respondents replied "no."
- ◆ The entire process seemed to group all defendants together for *Markman* without regard for individual differences and different circumstances. This is particularly harmful to small defendants. There needs to be protections against this. Willfulness needs to be bifurcated. Damages should be bifurcated.
- ◆ After the defendant answers, I would suggest sending out a letter advising the parties that their documents are likely to be due 45 days after the initial scheduling conference.

This would provide parties unaware of the typically short discovery period advance notice so they could begin document preparation.

- ◆ The Court should also consider using the Eastern District of Virginia's approach of allowing discovery to begin immediately after the defendant answers.
- ◆ Yes, expert reports should be filed first by a party with the burden of proof with rebuttal reports following.
- ◆ I would suggest that the PR document disclosure be clarified to explicitly state that all infringement / invalidity / patent defense documents are disclosed under that patent rules, and all other relevant documents, including damages, are disclosed under the Court's disclosure rule. Go back to the "Plan" rules of no objections or interruptions in a deposition except to assert a privilege.
- ◆ Allowing supplementation / amendment without leave of court of preliminary infringement and validity disclosures up until a certain stage of the case.
- ◆ The patent claimant should be permitted to take discovery on any products it believes may infringe its patents and should not be limited to those products identified in the preliminary infringement contentions.
- ◆ As discussed above, the preliminary infringement contentions and invalidity contentions are due within a short period of time after discovery begins. The parties should be allowed to conduct discovery on products that may potentially infringe and prior art systems that are not identified in the preliminary contentions. The parties should then be permitted to supplement their preliminary infringement contentions and their preliminary invalidity contentions based on any newly discovered information.
- ◆ As I said, I think that "rocket dockets" are very unfair to patent defendants, who must do ten times as much work as a plaintiff to prepare a patent case for trial. Defendants should not be bound by preliminary invalidity contentions because it often takes a long time to discover and investigate the prior art and depose the necessary third party witnesses, who often are reluctant to get involved in any litigation. The combination of all the work added by the Northern District of California patent rules and a "rocket docket" to trial is simply unfair to defendants. Typical times to trial in the Northern District of California are over 2 years and probably closer to 3.
- ◆ None other than the suggestions contained above.

**17. Do you have any suggestions on ways to make patent practice more effective?**



- ◆ 1 respondent replied "yes."
- ◆ The use of representative claims would greatly reduce the number of claims in the case which in turn reduces the number of claim terms in the case. This approach is used by judges in Delaware and the Northern District of Illinois and is akin to defining a count in interference practice before the PTO.

Basically, the plaintiff is required to group the claims into 1-4 groups and designate a representative claim for the group. The claims stand or fall based upon the representative claim. The litigation moves forward on just the representative claims.

Willfulness opinions should occur well before the *Markman* hearing. P.R. 3-8 does not specify when such opinions should be produced, but the Court's scheduling order requires production a few months prior to trial. A defendant's willfulness opinion will contain a claim construction which may be consistent with that offered by the plaintiff and different from that now offered by the defendants. In addition, production of an otherwise privileged opinion is a waiver of privilege on the subject matter (not just the document). As such, further discovery is warranted and it would be more efficient to fold this discovery into general discovery rather than "reopening" discovery on the eve of trial.

- ◆ I think it is quite efficient the way that it is currently is being implemented.
- ◆ The Court seems to have a good handle on the process.
- ◆ Yes. Do not change voluntary disclosure of documents. Limit objections to privilege. Publish decisions regarding the Court's interpretation of its patent rules. Allow some discovery to enable patentee to add accused products to preliminary infringement contentions that are discovered after suit is filed.
- ◆ None, other than above.
- ◆ It would be helpful if the Northern District of California rules were enforced by all judges in the District to encourage uniformity and efficiency.
- ◆ One suggestion is to use a four-part evidence presentation, so that the accused infringer has the last word on patent validity and enforceability. Likewise, in closing, the argument should be split so that the accused infringer has the last word on patent validity and enforceability.

Another suggestion is to eliminate the "presumption of validity" from the jury charge and only charge on the clear and convincing evidence standard.

Last is to abrogate the podium rule. Counsel should be allowed to move as long as such movement is not distracting and counsel can be heard by everyone.

- ♦ I personally don't think a defendant should have to do any preliminary invalidity contentions. It creates a lot of work because the defendant is afraid to leave anything out early in the case. Defendants should have until the expert reports are due to evaluate and decide the defenses presented at trial. Also, expert reports should not be due until at least 30 days after the Court issues its claim construction ruling to avoid unnecessary work "hedging" positions.
- ♦ It seems that a lot of effort has been put into the adoption of rules that make the practice as efficient as possible now. Judge Ward's local rules seem to be well received and workable. I would suggest that every effort be made to implement these local patent rules throughout the district.
- ♦ Delay damages discovery until after *Markman* ruling.